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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,584	08/30/2000	Howard N. Straub	RES-101A	9208

7590 03/01/2004
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EXAMINER

BUI, VY Q

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/650,584

Applicant(s)

STRAUB, HOWARD M.

Examiner

Vy Q. Bui

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 7, 9, 10, 13-16 and 18-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 11, 12 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I (claims 1-17) in Paper No. 10 is acknowledged. The traversal is on the ground(s) that the restriction should be withdrawn in the interest of efficiency because the art of all six groups would be searched in the prosecution of any one group. This is not found persuasive because six groups are clearly distinct inventions and an examination of all six groups would be a serious burden.

In addition, the elected Group I covers different species, which are distinct inventions as indicated in the "Office Action" paper 9. Because the applicant did not specifically elect which one of the species for examination, the 1st species shown in Fig. 1 (claims 1-6, 8, 11-12, 17) is considered as the elected species for examination.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. It is not clear what is the meaning of "a base curve of from about 8 to 9mm". Is "8 to 9mm" a length of a base curve" or "a radius of curvature of a base curve"?

Claim 3 recites the limitation "said arcuate stent" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what is the meaning of "a peak of about 7mm". Does this indicate the height of the stent measured from a base to a peak of the stent?

Claim 11 recites the limitation "proximal flanged" in line 1. There is insufficient antecedent basis for this limitation in the claim. Further, "flanged" does not appear grammatically proper.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5, 8, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by WONG-4,521,210.

As to claims -2, 5, 8, 12 , WONG (Figs. 3A-3C, 11-12) discloses a T-shaped stent including cross portion 40 and leg portion 42 having a bottom surface with an arcuate portion

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and a tapered planar portion 50 as claimed. The functional languages in the claims have been considered but not given much patentable weight because they indicate the intended use of the device only, and do not provide any further structural limitation to the device.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over WONG-4,521,210.

As to claim 6, PMMA is a well known stiff polymeric material suitable for making an eye implant. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make WONG stent of PMMA for PMMA is a well known material suitable for making an eye implant.

As to claim 17, WONG discloses a T-shaped stent having substantially every limitation as claimed, except for placing four of them in a sclera. However for device claims, patentability weight of a device or a plurality of the device cannot be based on the intended use of the device(s).

Specification

The disclosure is objected to because there are typo errors, such as: "5(b)" on line 15, page 6 should have been – 4(b)--; "leg portion (6)" on line 11, page 15 should have been – leg portion (4)--. In addition, same number "205" was labeled for both "The body" (page 12, line 20) and "arcuate peak" (page 12, line 22). Correction is required. See MPEP § 608.01(b).

Information Disclosure Statement

The information disclosure statement filed 1/28/2001, 4/9/2001 and 5/23/2002 have not been considered because they are not in the file. The Examiner has requested the Applicant to provide them so as they can be considered by the Examiner.

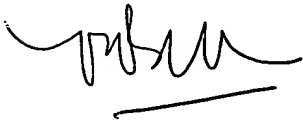
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 703-306-3420. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J Milano can be reached on 703-308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'VQB', with a horizontal line underneath it.

VQB
2/20/2004.